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| VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998 | | | EXAMINER ADDIE, RAYMOND W | |
| | | | ART UNIT 3671 | PAPER NUMBER |

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,414

Applicant(s)

RINNINGER, HANS JOSEF

Examiner

Raymond W. Addie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8, 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller B. Eagle Mfg. Co.*, 151 U.S. 186 (1894), *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Fogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Claims 1, 2, 5-8, 12, 14, 15, 18-22 are rejected under 35 U.S.C. 101 as claiming the same invention as that of prior U.S. Patent No. D448,092 S. This is a double patenting rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 12-15, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock # 957,985 in view of Rininger # 4,792,257.

McClintock discloses a concrete, cube-shaped paving stone (c) with sharp edged corners. Each face of said paving stone being planar such that the distances between

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the planar sides are equal and that each side of said paving stone can be used as the upper surface of the paving stone.

What McClintock does not disclose is a paving stone having a rounded portion.

However, Rinninger '257 teaches it is desirable to provide paving stones having planar sides, tops and bottoms; with clothodially-rounded portions (31) that extend over $\frac{1}{4}$ - $\frac{1}{6}$ th of at least one face; in order to improve water "flow-off" from the top surface of the stone. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the cube shaped paving stone of McClintock, with at least one clothodially rounded edge, in order to improve water drainage of the pavement formed by the paving stones.

In regards to Claims 13, 23 McClintock specifically discloses the desirable advantages to randomly spreading, leveling and grading the paving stones, to provide an aesthetically pleasing appearance and a strong, flat wearing surface provided by the paving stones. Rinninger teaches it is desirable to provide cuboidal paving stones with clothodially rounded edges, to at least a few of the paving stone faces, to permit surface water drainage, which inherently increases the safety of the paved surface, during rainfall. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to form the paved surface of McClintock, such that the paving stones are arranged in a random order, which permits at least a few of the paving stones to form drainage passages, as taught by Rinninger in order to increase the safety of the roadway.

3. Claims 3, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock # 957,985 in view of Rinninger # 4,792,257 as applied to claims 1, 14 above, and further in view of Scheiwiller # 5,348,417.

McClintock in view of Rinninger disclose using plurality of differently sized paving stones, in order to form a composite paving surface, having a varied and non-monotonous appearance. What McClintock in view of Rinninger does not disclose is the specific combination of paving stones to include additional blocks that are twice the length and/or twice the width of the standard cuboid stone.

However, Scheiwiller discloses a set of paving stones (1, 7), comprising a 1st molded block (10) having a square cross section, in plan view, and a 2nd molded block (7) having an oblong/rectangular cross section in plan view; with a width and height of edge dimension L equal to that of the 1st molded block and a length of edge dimension 2L.

Said set of paving stones (1, 7) can be combined in various patterns to form an appealing surface. See col. 1, ln. 49-col. 2, ln. 31.

4. Claims 3, 4, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock # 957,985 in view of Rinninger # 4,792,257 as applied to claims 1, 14 above, and further in view of Scheiwiller # 5,503,498.

McClintock in view of Rinninger disclose using plurality of differently sized paving stones, in order to form a composite paving surface, having a varied and non-monotonous appearance. What McClintock in view of Rinninger does not disclose is

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the specific combination of paving stones to include additional stones having an oblong/rectangular cross section in plan view; with a width and height of edge dimension L equal to that of the 1st molded block and a length of edge dimension 2L; nor the use of additional blocks that are square in plan view and with dimensions of four cubes with the size of 4 cubes lying beside one another.

However, Scheiwiller discloses a set of paving stones (33, 34, 35), comprising a 1st molded block (1) having a square cross section, in plan view, and a 2nd molded block (34) having an oblong/rectangular cross section in plan view; with a width and height of edge dimension L equal to that of the 1st molded block and a length of edge dimension 2L and a 3rd paving stone (35) having the size of 4 standard stones (33). Said set of paving stones (1, 7) can be combine in various patterns to form an appealing surface. See Fig. 8; col. 7, Ins. 14-23. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the paving stones of McClintock in view of Rinninger in a set of paving stones having a variety of sizes and shapes, as taught by Scheiwiller '498, in order to provide a paved surface having a varied appearance. See Scheiwiller '498 col. 2, Ins 62-68.

Response to Arguments

5. Applicant's arguments filed 04/08/2005 have been fully considered but they are not persuasive. Applicant argues against the double patenting rejection of Claims 1-8, 12-23 by reciting MPEP 1504.06, which describes the process of applying a double patenting rejection against a design patent application.

However, the double patenting rejection cited in the Last Office Action is directed to double patenting in a utility application, wherein the design patent is cited as the prior art, and not vice-versa as argued by Applicant.

In this case, all limitations of Applicant's claimed invention are clearly disclosed by the design patent; the fact the design patent does not include a "written specification" is irrelevant to what is disclosed by the prior art.

Hence, Applicant's arguments are not persuasive, and the double patenting rejection of claims 1-8, 12-23 as claiming the "same invention" is maintained.

Applicant argues in general, against the reference to McClintock by suggesting on page 11 of the response that "Specifically, the cubes are two inches on each side...and are not designed to be laid in a carefully chosen pattern to give a variegated appearance in the laid paving stone pattern" and suggests "This is in stark contrast to the ordered paver stone arrangements shown".

However, Applicant's arguments don't appear to be directed to any "actual claim language". Therefore, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Nothing in the claims require a "carefully chosen pattern to give a variegated appearance".

Applicant then argues "the pitch, grout cement, mortar or other material filling the spaces between the cubes of McClintock is likely to at least partially cover any rounded corners that might be put on the cubes and thus defeat the purpose of achieving a natural appearance like that achieved in the Rinninger '257 patent".

However, the Examiner does not concur.

Nothing in the claims nor the prior art require the use of a "pitch, grout, cement" as argued. The fact the prior art discloses a preferred method of making a roadway with the patented paving stones, is irrelevant to the paving stone claimed by Applicant. Applicant's claims are not directed to any specific steps or processes of using the claimed paving stone, Applicant's claims are solely directed to the structural features of the claimed paving stone.

To that affect, McClintock discloses a molded block for a paving stone covering, made of concrete, the block having approximately the shape of a cube. What McClintock does not disclose is providing the block with at least one rounded edge. However, Rinninger, Applicant's previously patented paving stone, clearly teaches an assortment of advantages to providing paving stones with at least one clothoidially rounded edge. See Col. 1, ln. 45-col. 2, ln. 47.

Therefore, the arguments are not persuasive and the rejection is maintained.

Applicant then argues "no incentive for one of...in the art, to place on the two-inch blocks of McClintock rounded corners that extend over at least 1/6 of their faces".

However, the Examiner does not concur.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the size of the paving stones) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case, nothing in the claims limits nor addresses the size of the paving stone claimed. Applicant's reliance on the prior art's disclosure of a block having a certain size, is irrelevant to the claimed invention, since such is not claimed.

Applicant then argues "Rinninger '257 patent discloses no face that is substantially planar over substantially its entire surface area".

However, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, the rejection of claim 1 is unpatentable over McClintock (who teaches a cuboid paving stone, in view of Rinninger '257, who teaches it is desirable to provide cuboidal paving stones with at least one clothoidially rounded edge, for various

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advantages and aesthetic appreciation.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues in favor of claims 5, 12, 18, 22 by stating "For the reasons presented above in connection with Claims 1 and 14, it would not have been obvious to provide on some of the blocks of McClintock et al., as the upper faces of laid blocks in a pattern, faces that are substantially planar over their entire surface areas".

However, The Examiner does not concur,

The reference to the McClintock clearly discloses a cube shaped paving stone that could obviously be disposed such that the upper faces of laid blocks are substantially planar over their entire surface areas.

Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, the arguments are not persuasive and the rejection of claims is maintained.

Applicant argues against the rejection of claims 3, 4, 16, 17 as being unpatentable over McClintock in view of Rinninger and further in view of Scheiwiller, by stating "Claims 3 and 16 depend on claims 1 and 14...it is submitted that claims 3 and 16 are allowable for the reasons presented...Scheiwiller '498 reference...does not provide a teaching

which could have rendered obvious the subject matter of claims 3 and 16".

However, the Examiner does not concur.

Claims 3 and 16 are drawn to an alternative embodiment requiring a block twice the length of the block of claim 1, which can be rotated about a horizontal axis, with a constant height; i.e. a rectangular shaped block.

To that extent, McClintock in view of Rinninger discloses a molded paving stone having at least one rounded edge, but does not disclose combining the blocks with blocks of different sizes. However, Scheiwiller '498 and Scheiwiller '417 disclose that block sets with blocks of different sizes within the sets can be combined in various patterns to form an appealing surface. See col. 1, ln. 49-col. 2, ln. 31.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues "it would not have been obvious to modify the two-inch cubes of McClintock to make some with an oblong/rectangular cross-section in plan view to make them with a length that is twice the width and height or to employ some blocks that have the dimensions of four of the cubes lying beside one another...The varying dimensions would increase the difficulty of raking the small blocks tight against one another".

However, the Examiner does not concur.

None of the claims require the blocks to be "raked tight against one another". In fact, the claims only require the blocks to be "laid adjacent to one another in a pattern".

To that affect, McClintock discloses a paving block (C) having a cube shape, that is capable of being laid on a surface, adjacent a plurality of similar cube shaped paving stones, to form a pathway, but does not disclose providing the blocks with a rounded edge. However, Rinninger, teaches it is known to provide cube shaped paving stones with at least one rounded edge, for various advantages, such as aesthetic appreciation.

Hence, Applicant's arguments are not persuasive and the rejection is maintained.

Applicant then argues "the fact that Scheiwiller '498 discloses large blocks of a size that are placed next to one another individually...does not mean that it would have been obvious to use such shapes with small blocks that are handled in bulk rather than individually".

However, the Examiner does not concur.

Firstly, Applicant's argument against obviousness is not based on any specific language of the claims, nor any specific disclosure of the prior art cited.

Secondly, nothing in the claims requires or limits the manner in which the blocks disposed "adjacent to one another in a pattern".

The fact primary reference discloses a method of placing paving stones on a roadway, wherein the paving stones are dumped from a cart; is irrelevant to the claimed invention. Because the claimed invention is drawn to a molded block, or a plurality of molded blocks that could be disposed adjacent one another, such that a substantially planar face of at least some of the paving stones is disposed as an upper face, and at

least some of the paving stones can be laid adjacent one another such that the face having a curved edge is disposed as an upper edge.

To that affect, McClintock discloses a cube shaped paving stone that can be disposed on a roadway or sub-base, such that any of the faces of the cube shaped paving stone can be an upper face of said paving stone. Further, Rinninger teaches it is desirable to provide cube shaped paving stones with a curved edge for aesthetic appreciation and other various advantages.

Therefore, the argument is not persuasive and the rejection is upheld.

Applicant finally argues "The handling of the small stones in bulk - dumping, spreading and raking together of the small stones - which is an essential characteristic of the McClintock reference, would not have resulted in any specific patterns even if some

stone of different shapes or sizes were included...In contrast the claimed blocks permit the 'stone mason' to position blocks of a minimum number of block types to create a wide range of paver stone patterns...There are cost, business and manufacturing advantages associated with the claimed block system".

However, the Examiner does not concur.

Regardless of how McClintock discloses placing the stones on a surface, none of the claims limit the manner in which the claimed invention is positioned on the ground.

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In spite of Applicant's argument that " the claimed blocks permit the 'stone mason" to position blocks of a minimum number of block types to create a wide range of paver stone patterns", such has no patentable weight, since the claims do not limit how the blocks can be disposed.

Therefore, the argument is not persuasive and the rejection is maintained.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Addie whose telephone number is (571) 272-6986. The examiner can normally be reached on Monday-Saturday from 7:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (571) 272-6998.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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RWA
6/24/2005